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OFFICE OF PETITIONS

In re Application of
Kristian Miller et al
Application No. 10/027,876
Filed: December 21, 2001
Attorney Docket No. SUN-P3434COB

ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 4, 2002, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of one or more prior-filed nonprovisional applications, namely, Application No. 09/573,042, filed May 15, 2000, and Application No. 09/274,742, filed March 23, 1999. For the reasons stated below, the communication entitled "Request to Correct Filing Receipt," received on February 8, 2002, will be treated as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.78(a)(3) is **DISMISSED** as moot.

The petition under 37 CFR 1.182 is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) of the prior-filed application, unless previously submitted;¹
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on December 21, 2001 and was copending with prior-filed nonprovisional Application No. 09/573,042. Further, nonprovisional Application No. 09/573,042 was copending with nonprovisional Application No. 09/274,742, at the time of filing. Petitioner now seeks to claim the benefit of priority to the above-noted nonprovisional applications under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2). A reference to the aforementioned, prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, which amendment was filed concurrently with the instant petition under 37 CFR 1.78(a)(3).

The reference to the above-noted, prior-filed nonprovisional application was not included in the manner specified in 37 CFR 1.78(a)(2) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2).

The current procedure where a claim for priority under 37 CFR 1.78(a)(2) is not included in an amendment to the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. However, on the other hand, if the USPTO does not

¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

note the claim for priority to the prior filed application(s) in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3).² In the instant case, the Office noted the claim for priority to nonprovisional Application Nos. 09/274,742 and 09/573,042 in the transmittal letter submitted with the application, as shown by its inclusion on the filing receipt. Therefore, since the application was scheduled for publication on the basis of the information contained elsewhere in the application, i.e., in the transmittal letter submitted with the application, the filing of the instant petition is unnecessary and is dismissed as involving a moot issue. In view thereof, the \$1,280 petition fee submitted is unnecessary.

In reviewing the application file, it is noted that a communication was received on February 8, 2002 requesting issuance of a Corrected Filing Receipt to list Kristian Miller as the first named inventor and Joseph Ferguson as the second named inventor. In a further review of the application file, it is noted that the declaration submitted with the application lists Joseph Ferguson as the first inventor and Kristian Miller as the second inventor. Petitioner is advised that the Office takes the order of the names of the inventors as they appear on the declaration as originally filed. Any request to change the order of the names of the inventors as they appear on the original declaration is more appropriately a petition under 37 CFR 1.182. *Note* MPEP Section 605.04(f). Accordingly, the communication received on February 8, 2002 will be treated as a petition under 37 CFR 1.182 and is hereby granted.

It is noted that a Corrected Filing Receipt may have been issued in this application in view of the change in the database of the change in the order of the names of the inventors. Nevertheless, a Corrected Filing Receipt accompanies this decision which shows the claim for benefit of priority to the above-noted, prior-filed nonprovisional applications and the order of the names of the inventors.

A petition under 37 CFR 1.182 requires payment of a fee of \$130. Since, as noted above, the \$1,280 petition fee submitted with the petition under 37 CFR 1.78(a)(3) was unnecessary, \$130 of the \$1,280 fee submitted will be applied towards to the fee for the petition under 37 CFR 1.182. Petitioner may request a refund of the excess balance of \$1,150 by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

² Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

Any questions concerning this decision on petition may be directed to the undersigned at (703)305-8680. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center AU 2123 for examination in due course and for processing of the amendment filed June 4, 2002.

A handwritten signature in cursive script, reading "Frances Hicks".

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt